



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,716	01/31/2001	Masayuki Chatani	375.07.01	7005

25920 7590 06/28/2005

MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE, CA 94085

EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,716

Applicant(s)

CHATANI ET AL.

Examiner

Carl Colin

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 88-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 88-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 4/4/2005 for a request to continue examination, applicant cancels claims 1-87 and adds claims 88-109. The following claims 88-109 are presented for examination.

1.1 In response to communications filed on 4/4/2005, applicant provides clarification of the new matter in the disclosure mentioned in the last office action. The argument has been fully considered and in response, the objection to the specification has been withdrawn.

2. Applicant's arguments, pages 11-12, filed on 4/4/2005, states that the references do not teach double encryption using public/private key pairs. Examiner respectfully disagrees. Applicant's further states that the key sent by the server in Uranaka is only encrypted by one public key, the user public key. Examiner disagrees. Uranaka discloses double encryption and the key (K_v) sent by the server is encrypted by two keys (one key from the server and one key from the user): a server key R and encrypted by a public key P_{ku} ; this is why it is called double-encrypted AP-encryption key (column 15, lines 1-4). In addition, the double encryption using public/private key pairs features that applicant relies upon on the amended claims are well known in the art and disclosed by Schneier. Schneier also discloses making sure that multiple keys are different and independent to benefit from multiple encryption. It is well known that using key pair provides more security than a shared key. The difference between the amended

Art Unit: 2136

claims and Uranaka is that Uranaka uses one key pair and a symmetric random key for double encryption whereas the invention uses two key pairs. This modification would have been obvious to use the random key as a key pair instead of using it as a shared key to provide more security because it is known that asymmetric cryptography is more secure than symmetric cryptography and a shared key may also be compromised during transmission as suggested by Schneier. Upon further consideration a new ground of rejection is made in view of Uranaka and Schneier.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1 **Claims 88-109** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,470,085 to **Uranaka et al** in view of Non-Patent Literature **Bruce Schneier**; "Applied Cryptography", 1996; John Wiley & Sons; Second edition; Pages 31-32, 39, 176-177, and 357-360.

3.2 As per claims 88-89, 94, 96-101, 106, and 108-109, **Uranaka et al** substantially discloses a method for enabling access to a software product, communication to enable the access to the software product being between a user computer and a server computer, the user computer executing program instructions to enable the method (column 4, lines 44-65), comprising: receiving user information from the user computer (column 3, lines 30-45);

Uranaka et al discloses generating server key pair at the server based on user's information that meets the recitation of user key pair (column 8, lines 34-41) and the server public key is obtained by the user (column 19, lines 2-10 and column 15, lines 55-67). **Uranaka et al** further discloses generating user key pair at the user computer that meets the recitation of console key pair and sending the user public key to the server to use for double encryption (column 7, lines 1-9; column 11, lines 13-20 and column 22, lines 26-36) and suggests that data transmitting with the service request can be encrypted (column 18, lines 61 through column 19, line 2); receiving a title ID from the user computer, the title ID identifying the software product for which access is desired, the title ID being encrypted by the user public key (column 22, lines 25-27 and column 18, lines 61 through column 19, line 2; and column 24, lines 30-40); retrieving a title private key based on the title ID received, the title private key being double encrypted by the server computer using the console public key and the user private key, use of the console public key created at the user computer defining a first layer of encryption, use of the user private key created at the server computer defining a second layer of encryption, the title private key and the title public key defining a title key pair (column 22, lines 29-36); and forwarding the double encrypted title private key to the user computer so that the user computer can use the title

Art Unit: 2136

private key to decrypt the software product encrypted by using the title public key (column 22, lines 36-50 and column 14, line 59 through column 15, line 21).

Uranaka et al discloses the invention as a whole comprising of exchanging at least three key pairs between the client and the server; suggests that data transmitting with the service request can be encrypted (column 18, lines 61 through column 19, line 2); and discloses the double encryption of a title private key K_v using a key generating by the user P_{ku} and a key generating by the server (R). **Uranaka et al** even discloses signing the double encryption key with a key pair (column 15, lines 55-67). The decryption steps in the claims, for instance in claims 96-97 are disclosed in **Uranaka et al** because they are just the reverse of the encryption steps cited above as known in the art of cryptography. The difference between **Uranaka et al** and the claimed invention is that the key (R) is a shared key.

It is well known that using key pair provides more security than a shared key. **Schneier** also discloses multiple encryption and suggests making sure that multiple keys are different and independent to benefit from multiple encryption. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Uranaka et al** to change the symmetric random key to an asymmetric key in order to provide more security as taught by **Schneier**. This modification would have been obvious to one skilled in the art to use the random key as a key pair instead of using it as a shared key because asymmetric cryptography is more secure than symmetric cryptography so it will provide more security because key may also be compromised during transmission and using different key that is known only to one party may benefit in security as suggested by **Schneier**.

Art Unit: 2136

As per claims 90, 95, 102, and 107, Uranaka et al discloses receiving purchase information from the user computer (column 12, lines 5-25); creating an electronic token based on the purchase information; and forwarding to the user computer, the electronic token that permits use of the decrypted software product in a restricted manner (column 12, lines 40-67).

As per claims 91 and 103, Uranaka et al discloses wherein the initiating of the access to the server computer is carried out by forwarding user information specific to the user computer to the server computer (column 5, lines 10-42; column 7, lines 57-67; and column 8, lines 34-41).

As per claims 92 and 104, Uranaka et al discloses different embodiments or alternatives of creating key pairs at the server based on user information (column 8, lines 34-42 and column 15, lines 21-67).

As per claims 93 and 105, Uranaka et al discloses wherein the console key pair is created by the user computer by using hardware identification means (column 18, lines 41-53; column 22, lines 26-36).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

Art Unit: 2136

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cc

Carl Colin

Patent Examiner

June 23, 2005


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100